



152

UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/763,810	01/23/2004	Cynthia C. Bamdad	M1015.70054US01	5010

7590

07/28/2006

JHK Law  
P. O. Box 1078  
La Canada, CA 91012-1078

EXAMINER

DAVIS, DEBORAH A

ART UNIT	PAPER NUMBER
----------	--------------

1641

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/763,810

Applicant(s)

BAMDAD ET AL.

Examiner

Deborah A. Davis

Art Unit

1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 121-131 is/are pending in the application.
- 4a) Of the above claim(s) 121-123, 130 and 131 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 124-129 is/are rejected.
- 7) ☒ Claim(s) 129 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group II, claims 124-129 in the reply filed on April 11, 2006 is acknowledged. The traversal is on the ground(s) that the two inventions have not been shown to impose a serious burden. This is not found persuasive because the MPEP 802.01 provides that restriction is proper between inventions which are independent or distinct. Here, the inventions of the two groups are distinct for the reasons set forth in the previous Office Action. As to the question of burdensome search, the inventions are classified differently, necessitating different searches. Further, classification is merely one indication of the burdensome nature of the search involved. The literature search, patent search, double patenting search which encompass different data bases and resources, in which the search does not appear to be coextensive. Different searches and issues are involved in the examination of each group. For these reasons the restriction requirement is deemed to be proper and is therefore made **FINAL**.

### **Status Identifiers**

2. Although applicant cancelled claims 2-120 in the previous office action, the status of the amendment should still identify claims 2-120 as previously cancelled in the current amendment response. Appropriate action is required.

***Claim Objections***

3. Claim 129 is objected to because of the following informalities: The limitation QCM or SPR in step d) should be spelled out. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 124-129 are rejected under 35 U.S.C. 102(e) as being anticipated by Hutchens et al (USP#6,225,047).

The claims are broadly drawn to a method of determining interactive characteristics of a first sample comprising exposing at least three surface regions, each exposing a different chemical, biochemical, or biological functionality to a second sample; (column 4, lines 21-43). Hutchens teaches a method of screening analytes in two sample cell extracts that are differently expressed and can be identified by exposing the sample cell extracts to a variety of adsorbent/eluant combinations for analysis by desorption spectrometry. The claim further recites determining an interaction pattern of the second sample with the at least three surface regions to which the second sample has been exposed indicative of an interaction characteristic between at least two

Art Unit: 1641

components of the second sample with each of the at least surface regions (column 13, lines 54-58) the adsorbent/eluant combinations are multiplex adsorbent characterized by many different species having different binding characteristics (interaction patterns) with the samples they are exposed to. The claim further recites comparing the interaction pattern of the second sample with the interaction pattern of the first sample (column 43, lines 49-57), wherein proteins that are differentially expressed in a sample compared to normal samples may be information in identifying diagnostic markers. With respect to claim 126 the samples can be drugs (column 11, lines 60-61). With respect to claim 127, the samples can comprise of a plurality of different species (column 13, lines 55-59). With respect to claim 128, the sample can comprise products of a cDNA library (column 17, lines 60-66). With respect to claim 129, Hutchens teaches that two different cell extracts containing analytes are exposed to many different species during the screening of libraries for drug candidates which examiner interprets to meet steps a) through c). Claim 125 further comprise exposing the second sample to a third sample prior to exposing the second sample to the three surface regions and comparing the interaction pattern of the second sample to the interaction pattern generated when the second sample has not been pre-exposed to the third sample. Hutchens teaches embodiments wherein surface regions 1 through 8 are exposed to a target protein 1 and target protein II (second sample) and protein – protein binding interaction is studied by desorption spectrometry (Figure 14, column 11, lines 45-48) and a drug candidate (third sample) is exposed to the second sample which is

Art Unit: 1641

target protein II and is monitored by desorption spectrometry (Figure 15, column 11, lines 49-59) which is interpreted to meet the limitation of claim 125.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

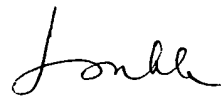
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A. Davis whose telephone number is (571) 272-0818. The examiner can normally be reached on 8-5 Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Davis Deborah can be reached on (571) 272-0818. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1641

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Deborah A. Davis  
Patent Examiner  
July 19, 2006

  
LONG V. LE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Substitute for form 1449/PTO

*(Use as many sheets as necessary)*

**Complete if Known**

Application Number	10/763,810
Filing Date	January 23, 2004
First Named Inventor	BAMDAD, Cynthia C.
Art Unit	1641
Examiner Name	Davis, Deborah A
Attorney Docket Number	M1015/70054US01

Sheet	2	of	2
-------	---	----	---

[illegible]

FOREIGN PATENT DOCUMENTS						
Examiner Initials*	Cite No. <sup>1</sup>	Foreign Patent Document	Publication Date MM-DD-YYYY	Name of Patentee or Applicant of Cited Document	Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear	T <sup>o</sup>
		Country Code <sup>3</sup> Number <sup>4</sup> Kind Code <sup>5</sup> (if known)				
DAB DAB DAB DAB	B7	WO 02/01225 A2	01-03-2002	MINERVA BIOTECHNOLOGIES CORPORATION	whole document	
	B8	WO 00/63701 A2	10-26-2000	THE BOARD OF TRUSTEES OF THE LELAND STANFORD JUNIOR UNIVERSITY	whole document	
	B9	WO 00/63694 A1	10-26-2000	UNIVERSITY OF VIRGINIA PATENT FOUNDATION	whole document	
	B10	WO 99/38013 A2	07-29-1999	XERION PHARMACEUTICALS GMBH	whole document	

**Examiner  
Signature**

Date  
Considered

7-18-04

\*EXAMINER: Initial reference considered whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant. <sup>1</sup>Applicant's unique citation designation number (optional). <sup>2</sup>See Kinds Codes of USPTO Patent Documents at [www.uspto.gov](http://www.uspto.gov) or MPEP 901.04. <sup>3</sup>Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup>For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup>Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST.16 if possible. <sup>6</sup>Applicant is to place a check mark here if English language Translation is attached.

This collection of information is required by 37 CFR 1.97 and 1.98. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

**If you need assistance in completing the form, call 1-800-PTO-9199 (1-800-786-9199) and select option 2.**





<b>Notice of References Cited</b>	Application/Control No. 10/763,810	Applicant(s)/Patent Under Reexamination BAMDAD ET AL.	
	Examiner Deborah A. Davis	Art Unit 1641	Page 1 of 1

**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,225,047	05-2001	Hutchens et al.	435/5
	B	US-			
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

**		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

Organization **IC3700** **DAVIS COLIPH**

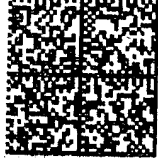
U. S. DEPARTMENT OF COMMERCE  
COMMISSIONER FOR PATENTS  
P.O. BOX 1450

ALEXANDRIA, VA 22313-1450

IF UNDELIVERABLE RETURN IN TEN DAYS

OFFICIAL BUSINESS

AN EQUAL OPPORTUNITY EMPLOYER



UNITED STATES POSTAGE  
02 1A  
0004204479  
MAILED FROM 2

USPTO MAIL CENTER

AUG 04 2006

RECEIVED

BYRD296 922783031 1105 39 08/01/06  
FORWARD TIME EXP RTN TO SEND  
BYRD  
2122 BULLION DR  
TWENTYNINE PALMS CA 92277-5024

RETURN TO SENDER

